

REMARKS**ALLOWABLE CLAIMS 15-16**

Applicant thanks the Examiner for the indicated allowability of claims 15 and 16. It is not believed to be necessary to amend claim 15 in independent form at this time, as it is submitted *infra* that the rejections of these base claims are improper.

35 U.S.C. § 103 REJECTIONS OVER McCASLAND AND DUNN

Claims 1 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **McCasland** (U.S. Patent No. 5,856,931) in view of **Cornett et al.** (U.S. Patent No. 5,216,612). Claims 4-14 and 20 are being rejected under 35 U.S.C. § 103(a) as being unpatentable over **McCasland** in view of **Cornett et al.** and **49 C.F.R. § 180.509**. These rejections are traversed.

McCasland is alleged to disclose an inspection method and system for, *inter alia*, railroad tanker cars (col. 3, lines 3-4) employing a reliability centered maintenance (RCM) analysis which predicts optimum maintenance task intervals based on continually updated past performance and failure. **McCasland** is acknowledged not to disclose or suggest “aligning various inspection requirements” and the Examiner cites **Cornett et al.** for teaching grouping maintenance activities in order to minimize lost production time (citing abstract). The Examiner concludes that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to group or align inspection in order to minimize lost production time”.

A. THE COMBINATION FAILS TO TEACH OR SUGGEST EACH AND EVERY ELEMENT OF CLAIMS 1, 4-14, 17, AND 20

The cited teachings of **Cornett et al.** (col. 10, lines 42-49) does not teach aligning of plural inspection activities. Immediately preceding this passage **Cornett et al.** state that “In other words, when the complex is unavailable for production due to an unplanned maintenance activity, planned maintenance which can be accomplished simultaneously is also performed, so that the complex need not be taken off line a second time a short time later to perform planned maintenance operations.” (col. 10, lines 36-42). Thus, the “grouping of maintenance activities” cited by the Examiner relates to opportunistically adding on of future planned maintenance activities when the complex is already made unavailable due to an unplanned maintenance activity (i.e., an emergency). However, the adding on of future planned maintenance activities appears to be conditional in that only planned maintenance *which can be accomplished simultaneously* is performed in addition to that required for the unplanned maintenance activity. It would therefore appear that any planned maintenance which might extend or otherwise interfere with the repairs for the unplanned maintenance would be avoided so as not to impact the return of the complex to service as soon as possible.

Thus, **Cornett et al.** fail to set forth teachings (or suggestions) to make up for the deficiencies of **McCasland**, which is recognized by the Examiner as failing to teach or suggest “aligning various inspection requirements”. In other words, **Cornett et al.** fail to generally teach or suggest aligning inspection requirements in the manner claimed and instead appears to teach, in the cited aspects of **Cornett et al.**, dealing with planned and unplanned maintenance. To the extent that the Examiner relies upon **Cornett et al.** for

teachings of aligning of inspection requirements, the Examiner is requested to point in **Cornett et al.** to the page and line wherein each feature of the claimed invention is asserted to reside. The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd*, 208 F.3d 1339 (Fed. Cir. 2000). Moreover, the Examiner is required to point to “page and line” of a reference wherein each feature of a claimed invention is asserted to reside. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984).

Cornett et al. also fail to specifically teach or suggest selecting from an instruction set comprising inspection sites covered by 49 C.F.R. § 180.509, Stub Sill Inspection Program, and Rule 88.B.2, a comprehensive list of sites to be inspected for the selected regulated tank car or non-regulated tank car comprising a plurality of inspection sites selected from at least two of 49 C.F.R. § 180.509, Stub Sill Inspection Program, and Rule 88.B.2, wherein the comprehensive list of sites to be inspected is selected so as to align inspections for said at least two of 49 C.F.R. § 180.509, Stub Sill Inspection Program, and Rule 88.B.2.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art”. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); *see also In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995)(stating “[w]hen evaluating the

scope of a claim, every limitation in the claim must be considered”). Neither **Cornett et al.** nor **McCasland** teach or suggest these particular limitations, as they do not relate in any manner to 49 C.F.R. § 180.509, Stub Sill Inspection Program, and Rule 88.B.2. The Examiner’s citation to **49 C.F.R. § 180.509** still fails to teach or suggest, in combination with **Cornett et al.** and/or **McCasland**, either of the claimed aspects regarding Stub Sill Inspection Program and Rule 88.B.2.

Still further, it is respectfully submitted that the rejected claims are not suggested by any combination of **49 C.F.R. § 180.509**, **Cornett et al.** and/or **McCasland**. The requisite motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103 is not an abstract concept, but must stem from the applied prior art as a whole and have realistically impelled one having ordinary skill in the art to modify a specific reference in a specific manner to arrive at a specifically-claimed invention. *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” See *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992). The Examiner must show reasons why a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, supra. The showing must be clear and particular. See, e.g., *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). This burden has not been discharged. For this reason as well, this rejection is traversed and reconsideration and withdrawal thereof is requested.

B. THE EXAMINER'S OFFICIAL NOTICE SUPPORTS FINDING OF NON-OBVIOUSNESS AS TO CLAIMS 1, 4-14, 17, AND 20

The Examiner may only take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being “well-known” in the art. *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970). The Examiner takes *Official Notice* with respect to the claim element “selecting for inspection one of a regulated tank car and a non-regulated tank car” that it is “widely known to differentiate inspection processes based on peculiar government requirements” and that “[n]on-regulated cars obviously do not require government mandated inspections and regulated cars do” (page 4 of Office Action). The Examiner’s *Official Notice* continues, “[o]ne of ordinary skill would withhold government mandated inspections intended only for regulated cars from non-regulated cars in order to save maintenance personnel the unnecessary effort”.

The specification states that “GE HM-201 is advantageously applied to non-regulated tank cars (i.e., those not regulated by DOT or the Federal Railroad Administration (FRA))” (Page 12, lines 22-23). The specification further states that “GE HM-201 additionally incorporates additional criteria not required by regulation” and that “the methods and procedures of GE HM-201 are applied not only to regulated commodities . . . but to all commodities transported by tank car” (page 13, lines 3-8).

Claim 1 recites *inter alia*, selecting for inspection one of a regulated tank car and a non-regulated tank car, selecting from an instruction set comprising inspection sites covered by 49 C.F.R. § 180.509, Stub Sill Inspection Program, and Rule 88.B.2, a comprehensive list of sites to be inspected for the selected regulated tank car or non-

regulated tank car, and inspecting each of the listed sites in accord with the instructions set forth for each of the listed sites in the instruction set, “wherein said comprehensive list of sites to be inspected comprises a plurality of inspection sites selected from at least two of 49 C.F.R. § 180.509, Stub Sill Inspection Program, and Rule 88.B.2”. Thus, in accord with the claim, non-regulated tank cars inspected to the requirements, per the claim, as the regulated tank cars.

A *prima facie* case of obviousness requires the examiner to present evidence, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, *or in the form of generally available knowledge at the time of the invention*, that would have led one of ordinary skill in the art to combine the relevant teachings in the proposed manner to arrive at the claimed invention. *See, e.g., Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); *Carella v. Starlight Archery*, 804 F.2d 135 (Fed. Cir. 1986). In this case, the Examiner’s Official Notice explicitly teach away from the claimed invention. Both the explicit language of the claims as well as the teachings of the specification which might be considered in light of the claim language run contrary to the Examiner’s *Official Notice*. The Examiner’s admission and statement of fact itself renders the invention non-obvious as the claim does not distinguish between regulated and non-regulated tank cars. The admission that “[o]ne of ordinary skill would withhold government mandated inspections intended only for regulated cars from non-regulated cars in order to save maintenance personnel the unnecessary effort” is, in light of the claim language and the specification, manifest evidence of the non-obviousness of the claimed subject matter. Such evidence of teaching away constitutes evidence of nonobviousness. *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *Specialty*

Composites v. Cabot Corp., 845 F.2d 981, 6 USPQ2d 1601 (Fed. Cir. 1988); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Marshall*, 578 F.2d 301, 198 USPQ 344 (CCPA 1978).

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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